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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,068	07/08/2003	Jurgen Woltjen	2003P09709US	7902

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Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

VEZERIS, JAMES A

ART UNIT	PAPER NUMBER
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3609

MAIL DATE	DELIVERY MODE
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09/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/615,068

Applicant(s)

WOLTJEN, JURGEN

Examiner

James A. Vezeris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/28/2005 and 7/8/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

Claim Objections

1. Claim 15 is objected to because it fails to ensure the coding described is executable by a computer. Un-executable code, even if on "computer readable medium", is non-statutory subject matter. Examiner notes that the claim will be reviewed as if the code were executable.
2. Claim 12 is objected to for being unclear in the terminology. The claim states, "means to assign quantified parameters to a at least one data record based upon." The use of the term "based upon" is not made clear in the claim and creates an ambiguous claim. The examiner notes the examination under the assumption the term "based upon" was a typo and was unintentional.
3. Claim 7 is objected to because of the following informalities: The term "to" is missing before the word "their" and after "according". Appropriate correction is required.

Claim Rejections- 35 U.S.C. 112 2nd Paragraph

4. The term "substantially" in claim 1 is a relative term, which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear how many patents the parameters must be assigned to in order for the method to work.

Appropriate correction is required.

5. Claim 15 is rejected under 35 U.S.C. 112 2nd Paragraph for being unclear in using the term "means to" instead of "means for" to try to invoke 35 U.S.C. 112 6th

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Paragraph. For the example it will be assumed that the applicant is not trying to invoke 35 U.S.C. 112 6th Paragraph.

Claim Rejections- 35 U.S.C. 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 15 is rejected under 35 U.S.C. 101 as failing to be statutory subject matter.

Section 2106.1 of the MPEP states, "When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory and should be rejected under 35 U.S.C. 101. The claim states "quantified parameters", bibliographic data", and "at least one indicator for high value patents", all of which are descriptive material. Since the descriptive material is non-functional it is non-statutory.

Claim Rejections- 35 U.S.C. 102(e)

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, and 12-15 are rejected under 35 U.S.C. 102(e) as being unpatentable over US Patent 6,556,992 to Barney et al. (Hereinafter "Barney")

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Regarding Claim 1:

Barney teaches a method of identifying high value patents in a patent portfolio, comprising:

Identifying a patent portfolio. (See Fig. 1, Column 6 Lines 52-57)

Assigning a plurality of parameters to substantially all patents of the patent portfolio. (See Fig. 1, Column 6 Lines 57-62)

Determining an overall quantified value of at least one patent within the patent portfolio based on-the assigned parameters. (See Column 23 and 24 Lines 56-2)

Identifying the high value patents according to the overall quantified value. (See Column 27 Lines 44-46)

Regarding Claim 2:

Barney further teaches a method, wherein the parameters are quantified. (See Column 6 Lines 57-62)

Regarding Claim 3:

Barney further teaches a method, wherein the quantified parameter is based upon if the patent overcame an opposition, a reexamination or a nullity procedure. (See Column 6 Lines 57-62)

Regarding Claim 4:

Barney further teaches a method, wherein the quantified parameter is based upon the patent has been cited in another patent or patent application. (See Column 14 Lines 3-5)

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Regarding Claim 5:

Barney further teaches a method, wherein the quantified parameter is based upon the age of the patent. (See Column 24 Lines 25-31)

Regarding Claim 6:

Barney further teaches the method, wherein the parameter is assigned to all patents. (See Fig. 1, Column 6 Lines 57-62)

Regarding Claim 7:

Barney further teaches a method, wherein the patents are ranked according to their overall quantified value. (See Column 24 Table 3)

Regarding Claim 8:

Barney further teaches a method, wherein the high value patents are listed at the top of a ranking. (See Column 27 Lines 44-46)

Regarding Claim 12:

Barney teaches a computer system for identifying high value patents in a patent portfolio, wherein each patent is represented by a data record comprising:

Means to obtain access to internal or external data bases to provide the patent portfolio.

At least one computer unit with:

Input means. (See Column 30 Claim 1)

Output means; (See Column 30 Claim 1)

Means to assign quantified parameters to at least one data record based upon; (See Column 30 Claim 1)

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Means to determine an overall quantified value of at least one patent within the patent portfolio based on the quantified parameters. (See Column 30 Claim 1)

Means to identify high value patents according to the overall value. (See Column 30 Claim 1)

Regarding Claim 13:

Barney further teaches a computer system, wherein the computer system consists of a plurality of computers. (See Column 30 Claim 1)

Regarding Claim 14:

Barney further teaches a computer system, wherein the computer system is connected to a plurality of databases providing patents to be identified. (See Column 30 Claim 1)

Regarding Claim 15:

Barney further teaches a computer program stored in a computer system or a computer readable medium for identifying high value patents in a patent portfolio, wherein each patent is represented by a data record comprising:

Quantified parameters. (See Column 30 Claim 1)

Bibliographic data. (See Column 30 Claim 1)

At least one indicator for high value patents. (See Column 30 Claim 1)

Claim Rejections- 35 U.S.C. 103(a)

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9-11 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,556,992 to Barney et al. (Hereinafter "Barney") in view of Official Notice.

Regarding Claim 9:

Barney fails to further disclose a method wherein identified high value patents are highlighted.

Official Notice is taken that it is old and well known in the art to highlight specific pieces of data.

Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to highlight the highly valued patents to make them clearer and easier for a user to locate.

Regarding Claim 10:

Barney fails to further disclose a method wherein the highlighting is based upon colors.

Official Notice is taken that it is old and well known in the art to highlight specific pieces of data using colors, such as found in Microsoft Office®.

Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to highlight the highly valued patents with color to make them clearer and easier for a user to locate.

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Regarding Claim 11:

Barney fails to further disclose a method wherein the highlighting is based upon colors.

Official Notice is taken that it is old and well known in the art to highlight specific pieces of data using colors, such as found in Microsoft Office®.

Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to highlight the highly valued patents with color to make them clearer and easier for a user to locate.

Regarding Claim 16:

Barney fails to further disclose a computer program that is implemented in Java.

Official Notice is taken that it is old and well known in the art to code a computer program in Java.

Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to utilize Java as the coding language because it allows for easy implementation onto a web based system.

Regarding Claim 17:

Barney fails to further disclose a computer program that is implemented in a conventional spreadsheet program.

Official Notice is taken that it is old and well known in the art to code a computer program in spreadsheet forms.

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Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to utilize a spreadsheet program as the coding language because it allows for easy implementation of the organization of information.

Regarding Claim 18:

Barney fails to further disclose a computer program that is implemented in Markup Language. Official Notice is taken that it is old and well known in the art to code a computer program in Markup Language.

Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to utilize Markup Language as the coding language because it allows for easy implementation onto a web based system.

Regarding Claim 19:

Barney fails to further disclose a computer program that is implemented in XML.

Official Notice is taken that it is old and well known in the art to code a computer program in XML.

Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to utilize XML as the coding language because it allows for easy implementation onto a web based system.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Vezeris whose telephone number is 571-270-1580. The examiner can normally be reached on Monday-alt. Fridays 7:30am-5:00pm.

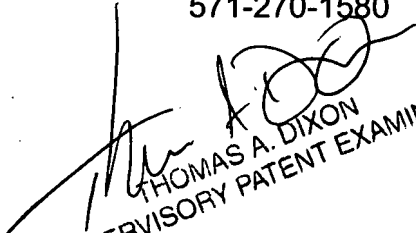
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

August 23, 2007

James Vezeris
Patent Examiner
571-270-1580



THOMAS A. DIXON
SUPERVISORY PATENT EXAMINER